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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,781	01/15/2004	Ali R. Rezai	12637/95	6304
23838	7590	07/19/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER LAYNO, CARL HERNANDZ	
			ART UNIT 3766	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/758,781

Applicant(s)

REZAI, ALI R.

Examiner

Carl H. Layno

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3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31, 32 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Acknowledgment is made of applicant's amendment, which was received by the Office on May 14, 2007.
2. Claims 1-30 are canceled. Claims 31-36 are active and pending.

#### ***Drawings***

3. Having reconsidered applicant's arguments regarding the drawings, and in view of the fact that claims 31-36 are directed to method claims, the Examiner is withdrawing the drawing objection under 37 CFR 1.83(a), which was made in the last Office action.

#### ***Specification and 35 USC 112 Rejections***

4. In view of applicant's explanations in the "Remarks" received on May 14, 2007, the Examiner is withdrawing the objection to the specification and the 35 U.S.C 112 rejections, which were made against claims 31-36 in the last Office action. Page 29, lines 23-28 of the present specification definitively describe an embodiment in which two portions of a patient's brain are stimulated at the same time.

#### ***Response to Arguments***

5. Applicant's remarks filed on January 19, 2007 with the submission of the RCE have been fully considered but they are not persuasive. The Applicant has taken the position that newly

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submitted claims 31-36 were not anticipated by either the John (US 6,066,163, or “John I”) patent or the John (US 6,463,328, or “John II”) patent under 35 USC 102 since neither reference specifically taught that the intra-laminar nuclei was one of the brain stimulation sites. The Examiner disagrees. Upon further review of the John (US 6,066,163 and 6,463,328) patents, the Examiner has discovered that the intra-laminar nuclei is one of the sites where a deep brain stimulation (DBS) electrode set may be located. Applicant’s attention is directed to col.5, lines 32-35 of John (US 6,066,163) and to col.6, lines 7-9 of John (US 6,463,328), which describe a number of possible electrode locations including the intra-laminar nuclei. Consequently, the Examiner is reintroducing the 35 USC 102 rejections using these references.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 31, 32, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by John (US 6,066,163).

In regard to claims 31 and 32, the John (US 6,066,163) patent describes an adaptive deep brain stimulation (DBS) method and system (Fig.1) for treating patients suffering from various brain dysfunctions (col.1, line 10). The system includes an embodiment in which two different electrode sets (DBS set #1 and DBS set #2 – Fig.3) for stimulating different portions of the brain are present. Applicant's attention is directed to col.5, lines 32-35, which describe possible electrode locations including the intra-laminar nuclei, the thalamic nuclei, and cortical areas of the brain, among others.

In regard to claim 34, the John patent is used to treat patient's suffering from traumatic brain injuries and comas (Abstract, line 3). Comas affect a patient's "conscious state" and "alertness".

In regard to claims 35 and 36, applicant's attention is directed to the plurality of EEG electrode sensors **12a** located on the patient's scalp (Fig.1). The examiner is taking the position that these sensors would be able to sense activity in areas of the brain of a patient having a psychiatric disorder. For a full discussion of EEG signals sensed, applicant's attention is directed to columns 7-9.

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8. Claims 31, 32, and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by John (US 6,463,328).

The John (US 6,463,328) patent describes a an adaptive deep brain stimulation (DBS) method and system similar to that of John '163, described above, having two electrode sets for deep brain stimulation (DBS set #1 and DBS set #2 – Fig.3) for stimulating different portions of the brain are present. Applicant's attention is directed to col.6, lines 7-12, which describe possible electrode locations including the intra-laminar nuclei, the thalamic nuclei, and cortical areas of the brain, among others.

In regard to claim 34, the John patent is used to treat patient's suffering from traumatic brain injuries and comas (Abstract, line 2). Comas affect a patient's "conscious state" and "alertness".

In regard to claims 35 and 36, applicant's attention is directed to the plurality of EEG electrode sensors 12a located on the patient's scalp (Fig.1). The examiner is taking the position that these sensors would be able to sense activity in areas of the brain of a patient having a psychiatric disorder. For a full discussion of EEG signals sensed, applicant's attention is directed to columns 8-10.

***Allowable Subject Matter***

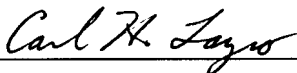
9. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (571) 272-4949. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CARL LAYNO  
PRIMARY EXAMINER

CHL  
7/1672007